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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,156	07/07/2000	James R. Muldoon	MULDOON-36045	8662

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,156

Applicant(s)

MULDOON, JAMES R.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-26, 28-41, 43-57 and 59-66 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-9, 11-26, 28-41, 43-57 and 59-66 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-9, 11-26, 28-41, 43-57, 59-66 have been examined.

Response to Amendment

2. The Amendment filed on 9/5/03 is sufficient to overcome the Barnett reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-26, 28-41, 43-57, 59-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett (6,321,208) in view of Day (5,857,175).

Claim: 1, 2, 3, 4, 7, 9, 20, 21, 24, 26, 37, 41, 50, 57: Barnett discloses a process for distributing product entitlements to frequent shopper program members, comprising the steps of: capturing frequent shopper program member data including individual member account numbers and related product purchase histories from a central retailer server using a computer network and transferring the captured data to a central host system database; comparing the product purchase history of each member account number to a database of available product entitlements;

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selecting a list of available product entitlements to be associated with each member account number based on the comparison (col 7, lines 35-55; col 8, lines 14-21; col 7, line 62-col 8, line 5; col 6, lines 49-52);

Barnett further discloses sorting the captured data by member account number and categorizing the product purchase history of each account number into various product categories (col 12, lines 37-62);

Barnett further discloses sending the selected list of entitlements to predetermined host system computers within individual retail stores (col 11, lines 39-44);

redeeming the product entitlements by matching the entitlements to universal product codes of purchased products scanned at a point-of-sale checkout stand (col 11, lines 39-44; col 11, lines 24-30); and

periodically transferring frequent shopper program member transactional data from the retail store to the retail store's central server (col 7, lines 35-55).

Barnett further discloses activating a dispenser that can be located at any location with a datalink which is accessible to frequent shopper program members by entering information identifying a frequent shopper member account number (Fig. 1; col 8, lines 51-67; col 6, lines 49-51; col 11, lines 2-5); and

communicating the previously selected list of entitlements for the frequent shopper member account number which activated the dispenser to the dispenser and printing the previously selected product entitlements (col 4, lines 60-67; col 4, lines 48-57).

Barnett does not explicitly disclose that his coupon dispenser that is located anywhere with a datalink can be located within a retail store.

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However, Barnett further discloses a coupon dispenser within a retail store that can be accessed by users for coupon selection and coupon printing (col 3, lines 35-44). Barnett further discloses that coupons can be transferred to a central repository or to a retail store (col 4, lines 64-68).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's personal computer coupon dispenser flexibly located to Barnett's coupon dispenser within a store. One would have been motivated to do this because being able to access the coupons at the store shortly before time of redemption at that store would be convenient to many users.

Barnett further discloses the printing step includes printing a shopping list of the previously selected entitlements (col 10, lines 24-26).

Barnett further discloses registering users as members of the coupon utilization program (Fig. 1; col 8, ;lines 51-67; col 6, lines 49-51; col 11, lines 2-5) and historic buying profiles (col 8, lines 15-22) and kiosk (col 3, lines 35-45).

Barnett does not explicitly disclose a frequent shopper program or tracking purchases without coupons or that the coupon dispenser is located with the retail store.

However, Day discloses distributing entitlements to shoppers who are member's of the retail stores frequent shopper program (col 5, lines 35-50; col 3, lines 23-32), obtaining member account numbers and member purchase histories with or without a coupon over a period of time (col 3, lines 23-32; col 14, lines 45-59), comparing the purchase history of the member to the available product entitlements (col 5, line 20-col 6, line 50), providing a dispenser within the retail store which is accessible and activated by a member by entering information identifying

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the member's frequent shopper account number (col 2, lines 9-17; col 4, line 41-col 5, line 5; col 5, lines 20-36), and communicating the previously selected entitlements for the frequent shopper member account number which activated the dispenser to the dispenser and printing the entitlements for the member (col 7, lines 50-59; col 10, lines 34-40).

Day further discloses that the coupon dispenser can be located at a variety of locations (col 4, lines 41-48)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Day's frequent shopper program, tracking purchases without coupon, and coupon dispenser within the store to Barnett's user profiling and targeted coupon providing. One would have been motivated to do this because purchase histories can assist in profiling a shopper and making the targeted coupons accessible to the user in the store would be convenient to some users.

Claim 5, 22, 38: Barnett and Day disclose the process of claim 1, 20, 37, and Barnett further discloses the printing step includes printing coupons representing the previously selected entitlements (col 4, lines 29-34; col 4, lines 64-67).

Claim 6, 23, 39, 51: Barnett and Day disclose the process of claim 5, 22, 38, 50, and Barnett further discloses the printed coupon includes product information, rebate information and a bar code thereon (Fig. 5).

Claim 8, 25, 40, 52: Barnett and Day disclose the process of claim 7, 24, 39, 51, and Barnett further discloses the redeeming step includes scanning the bar code on the printed coupon at the point-of-sale checkout (col 11, lines 10-13; col 11, lines 17-21; Fig. 5).

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Claim 11, 28, 43, 59: Barnett and Day disclose the process of claim 9, 26, 41, 57, and Barnett further discloses the printed shopping list is organized in such a manner that the frequent shopper program member is led through the retail store from the dispenser to the point-of-sale checkout in a convenient manner (col 10, lines 31-37).

Claim 12, 29, 44, 60: Barnett and Day disclose the process of claim 10, 28, 43, 59. Barnett further discloses that items can be ordered by type (col 10, lines 5-10) and organized in a list by location or layout in a store (col 10, lines 34-39). Barnett does not disclose that the layout or location instructions include aisle number.

However, it is inherent to many retail stores that they include aisle numbers for locating products in the store's layout.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add aisle number to Barnett's shopping list organized by product location for a specific retail store. One would have been motivated to do this because aisle number is a convenient way to locate a product in the layout of a store.

Claim 13, 30, 45, 61: Barnett and Day disclose the process of claim 9, 27, 42, 58, and Barnett further discloses the shopping list includes a bar code which identifies the frequent shopper program member account number (col 11, lines 1-10; col 10, lines 44-47).

Claim 14, 31, 46, 62: Barnett and Day disclose the process of claim 9, 27, 41, 57, and Barnett further discloses the step of relaying the previously selected list of entitlements sent to the dispenser to a retail store computer in order to allow the matching of the shopping list of entitlements to products purchased at the point-of-sale checkout during redeeming step (col 11, lines 37-44; col 10, lines 47-57).

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Claim 15, 32: Barnett and Day disclose the process of claim 14, 31, and Barnett further disclose the step of relaying the previously selected list of entitlements to the central retailer server (col 10, lines 47-57; col 11, lines 5-10).

Claim 16, 33, 53, 63: Barnett and Day disclose the process of claim 1, 20, 50, 57, and Barnett further discloses the step of periodically transferring frequent shopper program member transactional data from the retail store computer to the retail store's central server (col 7, lines 17-21; col 7, lines 35-55).

Claim 17, 34, 47, 54, 64: Barnett and Day disclose the process of claim 1, 20, 37, 50, 57. Barnett further discloses a unique user identifier (col 11, lines 1-5). Barnett further discloses a card bearing a magnet strip that includes coupon information for redemption in a store (col 3, lines 20-25). Barnett further discloses uniquely identifying a user at time of purchase (col 11, lines 17-24; col 12, lines 31-41).

Barnett does not explicitly disclose that the card identifies a user.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Barnett's uniquely identifying a user at time of purchase to Barnett's magnetic stripe card for coupon redemption at a retail store. One would have been motivated to do this because a magnetic stripe card is a convenient way of tracking a user's activity.

Claim 18, 35, 48, 55, 65: Barnett and Day disclose the process of claim 1, 20, 37, 50, 57, and Barnett further discloses the activating step includes the step of scanning a bar code containing the frequent shopper program member account number (col 11, lines 10-25).

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Claim 19, 36, 49, 56, 66: Barnett and Day disclose the process of claim 1, 20, 37, 50, 57. Barnett further discloses a user account (col 6, lines 49-51) and a unique account identifier (col 11, lines 2-5). Barnett further discloses a keyboard for user input into a terminal to access the user account (col 8, lines 52-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Barnett can input user account information via the keyboard. One would have been motivated to do this because a keyboard is a standard and convenient way of logging into a user account.

Response to Arguments

4. Applicant's arguments with respect to claims 1-9, 11-26, 28-41, 43-57, 59-66 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

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THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

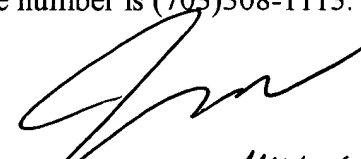
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

9/22/03


Thomas W. Myhr
Primary Examiner
Art Unit 3622